REMARKS/ARGUMENTS

1. Summary of the Office Action

Claims 1-6, 8-20, 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,832,222 (hereinafter Dziadosz).

Claims 7 and 21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dziadosz in view of U.S. Publication No. 2002/0059425 (hereinafter Belfiore).

2. Response to 35 U.S.C. § 102 Rejections

In response to the above Office Action, the Applicants have amended the claims and respectfully request reconsideration thereof. All the amendments are supported by the application as originally filed, for example, paragraphs [0025] and [0028]. Accordingly, no new matter has been added. Claims 9-14 have been canceled without prejudice.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants contend that each and every element of the present claims is simply not found in Dziadosz. Dziadosz teaches a data replication architecture that enables transparent replication of data or state information over a network of geographically dispersed processing units. However, Dziadosz does not teach the presently claimed feature of "**communicating an asynchronous event information from the at least one designated device** to the kernel of the operating system;" (Claim 1; emphasis added). Indeed, Dziadosz does not teach or even suggest providing an asynchronous event information. There is no reasons for Dziadosz to teach asynchronous event information as Dziadosz is only concerned with I/O devices.

Although the Office Action asserts that Dziadosz (Figure 3 and associated discussion in Col. 7) teaches that the operating system receives information from the designated device, this assertion is incorrect. Nowhere in Dziadosz is there any mention of the device providing

information to the operating system. At best, Figure 3 of Dziadosz only describes a method for "transparent replication of data along the second I/O path 38 (FIG. 2) from a local processing unit 12a to a sequential access device (e.g. tape drive) or a random access device (e.g. hard disk, optical disk, hardware RAID subsystem, software RAID) associated with one or more remote processing units 12b" (Col.7, lines 25-30). It will be noted that Dziadosz only teaches providing I/O requests from the processing unit to the device. Clearly, Dziadosz fails to teach each and every element of the present claims. Accordingly, the present claims are patentable over Dziadosz.

3.   Response to 35 U.S.C. § 103 Rejections

Claims 7 and 21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Dziadosz in view of Belfiore.

To establish a prima facie case of obviousness, however, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, there has been no showing of the required motivation for the suggested combination. The Office Action only suggests that it would have been obvious to one of ordinary skill in the art to combine the teachings of these references. This conclusion finds no support in the references. Indeed, the Office Action cites no motivation for such a combination, other than a general desire to provide an improved system (See Office Action, page 6). This rote invocation of a general desire to make existing technologies better is an insufficient basis for reaching a conclusion of obviousness. Instead, what is needed is an actual showing of motivation to make the desired combination.

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In addition, there has been no showing that one would expect success in combining the teachings of the reference. As established above, Dziadosz provides only for communicating I/O requests to a plurality of devices. There is no mention of the plurality of devices providing asynchronous event information to the operating system. Nothing in the references (nor in the Office Action) suggests how the event subscription technique disclosed in Belfiore could be adapted to operate in the environment described by Dziadosz. Consequently, there has been no showing of an expectation of success resulting from the combination of these references.

Rather than making out a proper prima facie case of obviousness then, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by the present Applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims. Indeed, the U.S. Court of Appeals for the Federal Circuit has rejected such applications of hindsight by specifically indicating that when an obviousness rejection is made based upon a combination of references, an examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added). Merely indicating, as in the present Office Action, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references in inadequate. *Ibid.*

As demonstrated above, the present Office Action deconstructs the subject matter of the claims into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support the present rejections. The burden is on the Examiner to show *why* one would be so motivated as to come up with the combination. *Rouffet* at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields the [Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight

analysis and rote application of the legal test for obviousness.") Accordingly, the present rejections should be removed.

4.   Conclusion

Having tendered the above remarks and amended the claims as indicated herein, the Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Jaina Chua at (408) 947-8200.

Respectfully submitted,

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